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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,132	07/25/2001	Jeffrey T. Randall	SEA0820P1120US	5741

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EXAMINER

JACYNA, J CASIMER

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

62N

# Office Action Summary

Application No.

09/915,132

Applicant(s)

RANDALL, JEFFREY T.

Examiner

J. Casimer Jacyna

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36,38-54 and 71-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36,38-54 and 71-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

1. The indicated allowability of claims 1-26 is withdrawn in view of the newly discovered reference(s) to WO 94/20713. Rejections based on the newly cited reference(s) follow. The finality of the last Office action is withdrawn in view of the newly cited art.

2. In regard to the rejection under 35 USC 251. As noted by Applicant in the reply of 11/1/2002, the claims have been broadened by omitting the limitation of sealing against the outside surface of the spout in that the first continuously curving sealing surface could be the inside diameter of the spout outlet conduit since the perimeter of a circle forms a continuously curving surface. Whereby the seal surface can now be against either the exterior or the interior of the spout. This limitation was misunderstood in the previous Office Action where the conduit 60 was viewed only in the axial direction and seen as a straight pipe section. This oversight is now corrected and the 35 USC 251 rejection is being reinstated for claims 27-36 and 38-54 in view of the fact that they have in actual fact been broadened to eliminate claiming the seal on the outside surface of the spout as explained above.

3. Claims 27-36, 38-54, 71-76 and 78 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the

application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Each claim of patent 5,938,087 included the limitation of a pry-off lid that "seals against an outside of said spout" (claims 1, 18 and 22), or is "arranged to seal around an outside of said spout" (claim 13). This limitation was not present in the originally filed claims, but was added to each claim in the amendment of 1/15/1999. Additionally, in the amendment of 1/15/1999, Applicant specifically argued on page 7, lines 16 and 21, that this limitation of the lid sealing on the outside of the spout was specifically added to overcome the Song et al. reference which did not include a lid which sealed on the outside surface (as stated on line 21). On page 8, lines 20-21, Applicant again contended the lid sealing on an external surface of the spout and stated this limitation overcame the De Nervo reference. Therefore, Applicant added the contested limitation in response to a rejection of the claims, and specifically identified this limitation as not being present in the cited prior art and also identified this limitation as a primary reason for allowing all of the claims of patent 5,938,087. Therefore, Applicant is barred from recapturing this omitted limitation from the claims because the broader scope was surrendered in the application, regardless of whether or not the limitation was actually needed to overcome the rejections.

Art Unit: 3751

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 7-10, 13-16, 18, 21-23, 27, 30, 32, 38, 39, 71, 77 and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/20713. WO discloses (see figures 4 and 5) a dispensing structure including a body 1 that extends from a container 4, a wall portion 7, a spout having a dispensing orifice therethrough as is the portion of 8 above wall 7, the wall portion 7 having an inside surface for forming a meniscus as is the area beneath 7 between 8 and 14 wherein the surface tension of a viscous fluid will cause the fluid to stick to the narrow gap between walls 8 and 14 and form a meniscus as claimed and similar to that shown at 134 in figure 3 of the current application. WO further discloses a conduit in fluid communication with the spout orifice that extends from an inside surface of wall 7 to a first free end as is the portion of 8 beneath wall 7, wherein 8 has a constant open area from the spout orifice to the lower conduit free end which area is free from obstructions as claimed. The measured width of the conduit portion of 8 beneath wall 7 is 1/8 inch or 0.125 inches which measurement is "about 0.11 inches" as claimed. The body of WO includes a surrounding wall structure 14 that extends from the inside portion of wall 7 and surrounds the lower portion of 8 as claimed. The lid of WO is disclosed as a snap-on lid that is synonymous with the term "pry-off" lid as claimed since the snap fastener is pried

off to unlatch the lid. The lid 2 of WO includes a collar 9 that seals against an outside portion of the spout.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/20713 in view of Dubach (5,497,906). WO discloses the claimed invention except that an upwardly curved spout is called for in claim 3 instead of the annular spout shown in figure 5 of WO. Dubach shows that an upwardly curved spout 16 in the body of a dispensing structure is an equivalent structure known in the art. Therefore, because these types of spout configurations were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the upwardly curved spout 16 as taught in Dubach for the annular spout as disclosed in WO especially since either spout configuration would function equally well in the device of WO.

8. Claims 6, 11, 12, 26, 31, 33, 34, 42-44 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/20713 in view of De Nervo (5,782,388). WO discloses a dispensing structure substantially as claimed but does not disclose a surrounding container seal. However, De Nervo teaches another dispensing structure having a surrounding container seal 36 for the purpose of ensuring that fluid does not leak out of the container. Therefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to provide the structure of WO with a surrounding container seal as, for example, taught by De Nervo in order to ensure that fluid does not leak out of the container.

In regard to claim 12, WO discloses the claimed invention except a threaded attachment to the container 5 is called for in claim 12 instead of the snap-fit connection disclosed in the Abstract. De Nervo shows that a threaded connection to the container is an equivalent structure known in the art. Therefore, because these types of container fasteners were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the threaded connection as taught in De Nervo for the snap fit as disclosed in WO especially since either container fastener would function equally well in the device of WO.

In regard to claim 26, WO discloses the claimed invention except a spout passage greater than the conduit passage is called for in claim 26 instead of the smaller conduit passage disclosed in the WO. De Nervo shows that having a larger spout passage 4 is an equivalent structure known in the art. Therefore, because these two types of spout passages were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the larger spout passage as taught in De Nervo for the larger conduit passage as disclosed in WO especially since either spout passage would function equally well in the device of WO.

In regard to claim 31, WO discloses a dispensing structure attached to a generic fluid container substantially as claimed but does not disclose any specific structure for the container nor the type of fluid dispensed. However, De Nervo teaches another

dispensing structure that also attaches to a fluid container that may have either rigid or flexible or squeezable construction (see col. 2, lines 9-10) and may contain either viscous or non-viscous fluid material (see col. 1, lines 6-7) for the purpose of providing a usable structure for the container and a desired fluid within the container. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the structure of WO with viscous material in a squeezable container as, for example, taught by De Nervo because one of ordinary skill in the art would have realized that the generic container 4 disclosed in WO had a specific but undisclosed structure and also dispensed a specific but undisclosed fluid and De Nervo clearly teaches that container attached dispensing spouts of a similar structure to that disclosed in WO may be attached to a variety of container types with a variety of fluids in order to provide a physical container with a desired product that a person could utilize which container and fluid types include squeezable containers with a viscous fluid.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/20713 in view of Beck et al. (5,219,100). WO discloses a dispensing structure substantially as claimed but does not disclose a plurality of tubular portions. However, Beck teaches another dispensing structure having a plurality of tubular portions for the purpose of controlling the rate of dispensing from the container. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the structure of WO with a plurality of tubular portions as, for example, taught by Beck in order to control the rate of dispensing from the container.



Art Unit: 3751

10. Claims 19, 20, 24, 25, 28, 29, 40, 41 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/20713. WO discloses a dispensing structure substantially as claimed but does not disclose the outlet orifice to be 0.11 inches in diameter nor the conduit to have a length of 0.34 inches. However, if the container and dispensing structure disclosed in WO were to be scaled down to enclose a smaller volume of fluid, then the outlet orifice and conduit would also be smaller to match the smaller container and container outlet opening and would then read on the claimed dimensions. It is noted that a mere change in the size of a package or container over that disclosed in the prior art is insufficient to establish patentability in a claim as noted in MPEP 2144.04, section IV.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dubach/239 is a US filing of WO 94/20713.

12. In regard to the rejections over the prior art, Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

13. In regard to the 251 rejection, Applicant's arguments filed 11/1/2002 have been fully considered but they are not persuasive. Applicant contends a number of prior decisions. However, the most recent decision that is currently being enforced by the Office is Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (CAFC 2001) issued 7/25/2001. This decision clearly supercedes the decisions cited by Applicant and clearly states that an alternate narrowing of the claims is not allowed and will not avoid the 35 USC 251 recapture rule.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 703-308-1508. The examiner can normally be reached on Mon.-Fri. 10AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7766 for regular communications and 703-308-7766 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

A handwritten signature in black ink, appearing to read "J. Casimer Jacyna", with a long, sweeping horizontal line extending to the right.

J. Casimer Jacyna  
Primary Examiner  
Art Unit 3751

JCJ  
November 26, 2002